

U.S. Appln. No. 09/604,285 - GATTO et al.

### REMARKS

Applicants respectfully request reconsideration and allowance of their reissue application.

#### Rule 133 Statement

Applicants' representative acknowledges with appreciation the Examiner's courtesy during a telephone discussion conducted on Friday, February 20, 2004. Applicants' representative agreed that a terminal disclaimer would be filed to overcome the non-statutory obviousness type double patenting rejection over the claims in the parent reissue patent. Claims 59, 60, 64 and 76 were discussed. In claims 59 and 60 the expression 'at least' was discussed and whether or not to delete the phrase. It was noted that the original specification disclosed to those skilled in the art that 104 ppm or more molybdenum could be present and the specification similarly supported 156 ppm or more molybdenum, which was intended with claims 59 and 60. In claim 64 the expression "about 104 to 468 ppm" was discussed. The word "about" was intended to modify 104 ppm. In claim 76, the amount of molybdenum present is greater than about 100 ppm but ascertained in relation to the ratio recited in the claim. Finally, inquiry was made to ascertain whether the Examiner had reconsidered and would withdraw remaining rejections, and it is understood by Applicants representative that the other rejections have been withdrawn and this case would receive favorable consideration once the terminal disclaimer is submitted and wording of claims 59, 60, 64 and 76 is resolved.

#### The claims, including the amended claims

The Examiners previously requested Applicants to supply a list of claims pursuant to 37 C.F.R. 1.121(b). Office Action, page 9. To comply with the Examiners' request, and in an effort to be consistent with what appears to be the directive in MPEP 1453, 37 C.F.R. §1.121(i) and §1.173, all reissue claims are presented with underlining. Brackets or strike outs to show amendments to pending but 'new' reissue claims do not appear to be required according to MPEP 1453 and Rule 173.

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Upon entry of this Amendment, claims 22, 23, 25-40, 42-52 and 56-80 will be presented for examination. The claims are supported by the original specification and there is no new matter.

Reissue claims 22 and 23 remain pending. Amended claim 22 and amended claim 23 are presented in accordance with 37 C.F.R. 1.173 and MPEP 1453 and recite an amount of molybdenum in accordance with the original specification (ppm molybdenum based on the weight of the lubricating composition) to obviate the objection based on new matter. Attention is respectfully directed to column 5, lines 60-63 ("based on the weight of said lubricating composition"). The Examiners are also respectfully invited to page 23 in the January 16, 2004 Amendment where claims 22 and 23 are discussed further. Claims 22 and 23 recite that the oil soluble molybdenum compound is free of phosphorus and free of active sulfur and the comments in the Office Action at pages 5-6 about substantially free of active sulfur are not germane to these claims. Claims 22 and 23 recite ratios of components in accord with the original specification and attention is invited, for instance, to column 6, lines 47-56. Amended claim 22 recites "said oil soluble molybdenum compound and said secondary diarylamine are present in an effective antioxidant amount" to replace the expression "said oil soluble molybdenum compound is present in an amount to be effective as an antioxidant." The amended expression finds basis in the original specification throughout, including the Examples, such as Example 5.

Claim 24 was canceled in a prior amendment.

Claims 25-40 and 42-51 are included in the listed claims as a courtesy so as to provide the Examiners with one set of claims for their review. It is thought that such previously submitted 'new' reissue claims are supported in Applicants' original specification throughout, including passages cited in prior submissions. Attention is respectfully invited to the reissue oath.

Amended claim 52 recites sulfur-free and phosphorus-free and that the composition is

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adapted for lubricating an internal combustion engine. The amendment finds support throughout the original specification and attention is invited, for instance, to the support for claims 22-23 and to columns 14-15.

Claims 54-55 were previously canceled as reflected in the listed reissue claims.

Claims 56-63 are included in the listed claims as a courtesy so as to provide the Examiners with one set of claims for their review. It is thought that such previously submitted 'new' reissue claims are supported in Applicants' original specification throughout, including the Examples. Attention is respectfully invited, for instance, to columns 14-15 and the Table V in column 15 in conjunction with the summary of the invention. However, claim 59 has been amended to recite "greater than about 104 ppm" and claim 60 has been amended to recite "greater than 156 ppm" and attention is invited to Table V. In addition, claim 61 has been amended to recite "wherein said oil soluble molybdenum compound provides 468 ppm molybdenum" instead of "less than about 468 ppm." Attention is again respectfully invited to Table V. Applicants additionally, separately addressed these claims elsewhere in their January 16, 2004 Amendment.

New claim 64 finds basis in the original specification throughout. The oil soluble molybdenum compound is a molybdenum carboxylate and is therefore in accord with the original, surrendered patent grant. The secondary diarylamine compound comprises an alkylated diphenyl amine compound and attention is directed to columns 5-6 and also, for instance, to column 14, penultimate line. The amount of molybdenum provided by the molybdenum compound finds support in the original specification, such as the Summary of the Invention when taken with Table V, and attention is directed to column 5, lines 60-63 ("based on the weight of said lubricating composition"). The specification provides basis for the range of about 104 ppm to 468 ppm molybdenum as seen from Example 5 and ex parte Jackson, 110 U.S.P.Q. (BNA) 561, 562 (Bd.App. 1956) (ranges recited in claims based on examples). The word "about" applies only to the "104 ppm." The ratio of the molybdenum to the parts by weight of the secondary diarylamine compound finds support in

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the original specification at column 6, lines 47-56.

New claim 65 finds support in the original specification and Table V and column 15, lines 50-52.

New claim 66 finds support in the original specification in column 15, Table V.

New claim 67 finds support in the original specification throughout and attention is invited, for instance, to column 7, lines 36-51.

New claim 68 finds support in the original specification throughout and attention is invited, for instance, to column 4, last several lines to column 5, line 48 and the Examples.

New claim 69 finds support in the original specification throughout and attention is invited, for instance, to column 5, lines 54-56, among other passages.

New claim 70 finds support in the original specification throughout and attention is invited, for instance, to column 5, lines 58-59, among other passages.

New claim 71 finds support in the original specification throughout and attention is invited, for instance, to column 2 and column 6.

New claim 72 finds support in the original specification throughout and attention is invited, for instance, to column 6, lines 12-21 from the end.

New claim 73 finds support in the original specification throughout and attention is invited, for instance, to column 6, lines 12-21 from the end.

New claim 74 finds support in the original specification throughout and attention is invited, for instance, to columns 14-15 and to Example 7 at column 16. Example 7 discloses

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lubricating an internal combustion engine with a composition that is in accord with claim 64.

New claim 75 finds support in the original specification throughout and attention is invited, for instance, to columns 14-15 and to Example 7 at columns 16. Example 7 discloses an internal combustion engine lubricated with a composition that is in accord with claim 64.

New claim 76 finds support in the original specification throughout. The lubricating composition recites an antioxidant combination. The antioxidant combination finds support in the specification throughout. The Examiner will appreciate the reference to the antioxidant mixture of components disclosed at column 8, lines 51-52 ("[t]he molybdenum/diaryl amine based antioxidant mixture ..."). The amount of secondary diaryl amine finds support in the original specification throughout and is consistent with the claims of Applicants' original, now surrendered original patent grant. The amount of molybdenum from the oil soluble molybdenum compound is defined according to a ratio disclosed at column 6, lines 47-56. The recitation of at least about 100 ppm of molybdenum finds support throughout the specification inasmuch as the original specification discloses from about 100 ppm and greater amounts and attention is invited, for instance, to column 15, including Table V, which discloses 104 ppm molybdenum, provided the overall range for molybdenum is described within the claim via the ratio.

Claim 77 defines the secondary diarylamine as consisting essentially of a secondary diphenyl amine and this finds support in the original specification throughout and is consistent with Applicants' original, now surrendered original patent grant. Attention is invited, for instance, to column 6.

Claim 78 defines the oil soluble molybdenum compound consistent with the original specification throughout and is consistent with Applicants' original, now surrendered patent grant. Attention is invited to columns 4 and 5.

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Claims 79 and 80 find support in the original specification throughout and attention is invited, for instance, to column 6, lines 31-22 from the bottom.

**Obviousness-Type Double Patenting Rejection**

A Terminal Disclaimer is enclosed.

**Other Rejections**

It is understood that the prior arguments in the January 16, 2004 Amendment form part of the record herein and are incorporated herein by reference, whereby it is further understood from the telephone discussion with the Examiner this date that the rejections, including the prior art and written description rejections, have been (will be) reconsidered and withdrawn.

**Conclusion**

Applicants respectfully solicit reconsideration followed by favorable action. A terminal disclaimer as to Re 37,363 is being concurrently submitted upon indication that the other rejections have been (or are being) withdrawn. The claims define unobvious subject matter and are supported by the specification. If the Examiner has any questions, please contact the undersigned. Otherwise, a Notice of Allowance is earnestly, but respectfully, solicited.

Respectfully submitted,

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